

Remarks

The Examiner rejected claims 1-4 and 6-9 under 35 USC § 102 as being anticipated by U.S. Patent No. 5,146,697 to Weiss ("Weiss") and claims 1-10 under 35 USC § 103 as being unpatentable over Weiss in view of U.S. Patent No. 4,685,223 to Long ("Long"). Based on the foregoing amendments and following remarks, Applicant respectfully submits all claims should be allowed because Weiss and the combination of Weiss and Long do not disclose, teach, or suggest all limitations of Applicant's claimed invention.

All claims require an outsole having a notch, where the notch is defined by an outermost periphery of the outsole, an inner periphery smaller than the outermost periphery, a top surface extending generally perpendicular to and connecting the inner and outermost peripheries together, and a vertical wall extending in a generally downward direction proximate to the inner periphery and connecting the top surface of the notch to the bottom surface of the outsole. Neither Weiss nor Long describe a notch having these features, all of which are required in all of Applicant's claims. Also see Applicant's figures 1-3.

Weiss shows and describes a notch in the bottom of the outsole but the notch is not defined by an outermost periphery of the outsole, as required in all of Applicant's claims. As shown in Weiss' figures 2 and 3, the notch is well within the outermost periphery of the outsole.

Long shows and describes a notch in the side wall of the outsole but the notch is not defined by an inner periphery smaller than the outermost periphery, a top surface extending generally perpendicular to and connecting the inner and outermost peripheries together, and a vertical wall extending in a generally downward direction proximate to the inner periphery and connecting the top surface of the notch to the bottom surface of the outsole. All of these limitations are required in all of Applicant's claims.

Because Weiss does not disclose all limitations set forth in Applicant's claims, Weiss does not anticipate Applicant's claims and the rejections under 35 USC § 102 should be withdrawn.

Because neither Weiss nor Long teach or suggest a notch defined by an outermost periphery of the outsole, an inner periphery smaller than the outermost periphery, a top surface extending generally perpendicular to and connecting the inner and outermost peripheries together, and a vertical wall extending in a generally downward direction proximate to the inner periphery and connecting the top surface of the notch to the bottom surface of the outsole, the combination of Weiss and Long also does not teach or suggest Applicant's invention absent some modification to the combination. However, such modification would be improper.

In order for a combination of references to be properly modified in a rejection under 35 USC § 103, there must be some teaching or suggestion in the references to make the suggested modification. Absent the requisite teaching or suggestion, the modification would be improper. As mentioned above, there is no teaching or suggestion in the cited art to have a notch defined by an outermost periphery of the outsole, an inner periphery smaller than the outermost periphery, a top surface extending generally perpendicular to and connecting the inner and outermost peripheries together, and a vertical wall extending in a generally downward direction proximate to the inner periphery and connecting the top surface of the notch to the bottom surface of the outsole. In fact, Weiss teaches away from having a notch defined by the outermost periphery because Weiss teaches that a notch is to be a periphery smaller than the outermost periphery of the outsole. Moreover, Long teaches away from having a notch defined by an inner periphery that is smaller than the outermost periphery of the outsole. In fact, Long teaches a notch that is defined by the outermost periphery only as Long's notch is limited to a sidewall in the outermost periphery. Given the teachings

away in both references from a notch to be defined by such parameters, never mind there not being any requisite teaching or suggestion in any of the references to have a notch defined by such parameters, Applicant submits there is no motivation for one skilled in the art to modify the references to include such limitations. Because the references teach away from Applicant's claimed notch, a combination of Weiss and Long do not make Applicant's claimed invention obvious and the rejections under 35 USC 103 should be withdrawn.

Respectfully submitted,



Gene S. Winter, Registration No. 28,352
David Chen, Registration No. 46,613
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155